

REMARKS

Introduction

Claims 1-31 are pending, with claims 1-27 have been amended herein. Claims 28-31 have been added. Reconsideration of the patentability of the claimed subject matter is requested in view of the foregoing amendments and following discussion.

§ 103 Rejection

On page 2 of the office action, claims 1-27 have been rejected under 35 U.S.C. §103(a) as being anticipated by Wild et al., U.S. Patent No. 5,862,480 (*‘Wild’*) in view of Horn et al., U.S. Patent No. 6,192,414 (*‘Horn’*). Applicants respectfully traverse this rejection.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be “expansive and flexible” and “functional.” However, the standard is not controlling, rather, the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in *KSR* has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

Applicants submit that Wild, even with Examiner's modification, would require a first connection to generate a priority list and that the generation occurs not on the electronic device, but on a server. Regarding claim 1, Examiner states that Wild, fig.12, steps 1202-1204, fig. 17, col. 9, line 36 to col. 10, line 65 teaches, "[a]ssociating one or more alternative network link designations with one or more of said network links based upon a priority assigned by the user of said computer system." Figure 12 has no relevance to the present invention as claimed: "*FIG. 12 illustrates a flowchart of a method for an access server to determine SU access privileges in accordance with a preferred embodiment of the present invention,*" Col. 3 lines 30-32, emphasis added. Additionally Figure 17 has no relevance to the present invention as claimed: "*FIG. 17 illustrates a flowchart of a method for an SU to request a list of accessible networks in accordance with an alternate embodiment of the present invention.*" Col. 3 lines 46-48, (emphasis added). Wild involves a server that determines and discovers if a device has access and then generates a priority list. Claim 1 states "*if said step c) fails to establish said first network link and if said particular alternative network link designation is associated with said first network link, attempting to initiate, by said electronic system, a particular network link of said plurality of network links based on said particular alternative network link designation.*" As such, the device already contains a list and if an attempted connection is rejected it traverses its own list.

Additionally, the Examiner has cited Col 9 line 36 – Col. 10 line 65, which does not cure Wild's defect For example, Wild states:

In a preferred embodiment, the access server receives SU RF capabilities information in step 1220. The SU RF capabilities information indicates which air interfaces the particular SU is capable of communicating over. The SU RF capabilities information can be received in the network access query or as a separate message. In step 1222, the access server determines which of the

networks from step 1216 the SU has the RF capabilities to communicate with. This determination is made by comparing the SU RF capabilities with network air interface standards 1224 stored at the access server. The purpose of steps 1220 and 1222 is to screen out networks which the SU is incapable of communicating with. In alternate embodiments, the GW or the SU can perform the capabilities-screening function and steps 1220 and 1222 need not be performed by the access server. (Col. 10 lines 19 – 33, emphasis added)

As stated, the server is performing the decision process and not the device. Moreover, it also shows that the list is not pre-existing to the attempted connection.

In regard to the portion “b” of the claim: “requesting a first network link of said plurality of network links,” even if Wild teaches connecting to a first connection of a plurality of connections in a priority order, it obtains the priority list only after attempting a first connection.

Next, Examiner states that Fig 12 at step 1216 and 1214 teaches “[d]etermining whether a particular alternative network link designation is associated with said first network link.” Applicants disagree. Wild requires an initial connection and also requires the stated process to be carried out by a server and not the device as claimed by the present invention. Additionally, Wild does not teach “*if said step c) fails to establish said first network link and if said particular alternative network link designation is associated with said first network link, attempting to initiate, by said computer system, a particular network link of said plurality of network links based on said particular alternative network link designation.*” Even if Wild teaches that the “indicated priority from the server and the list is stored on the user's device,” Applicants submit, that the present invention as claimed does not “associat[e] one or more alternative network link designations with one or more of said network links based upon a priority order assigned by the user of said electronic system and residing on said electronic system.” As such, Wild, even with the Examiner’s modification, would require a first connection to generate the list, where the list is generated not by the electronic device, but by a server.

Also, Applicants submit that Wild is in a different field of endeavor from the present invention as claimed. Wild teaches operation within radio telecommunication networks and looks to connect to only a plurality of diverse networks. However the present invention as claimed teaches connecting to a plurality of types of connections or links, for example, wired Ethernet, WiFi, Cellular, etc. Wild states:

In a typical radio telecommunication network, an SU's first point of contact is a Base Station Subsystem (BSS). The BSS provides and manages transmission paths between SUs and the network's Mobile Switching Center (MSC). An MSC is a point where subscriber authentication is performed and where communications transit between the network and another network (e.g., a Public Switched Telephone Network (PSTN) or other communication network). To determine whether an SU is allowed to use the network's services, information identifying the SU is sent from the BSS to the network's MSC. After receiving information about the SU, the MSC performs an authentication procedure to determine whether the SU is authorized to use the network. For an SU in roaming mode, the MSC also determines whether the network and the SU's home network have an agreement in place which ensures that the network will receive compensation for service it provides to the SU (Col 3 line 60 – Col 4 line 9)

As such, Wild is not meant to perform in the same environments or perform similar tasks.

Accordingly, Applicants respectfully request the Examiner withdraw this rejection.

Furthermore, Horn does not cure Wild's defects. For example Horn states:

A system for and a method of managing a communications network through the use of multiple network connections. The system prepares at least two transport service providers of a node for establishing a network connection with corresponding transport service providers of another node and associates the at least two transport service providers with each other and with a requesting application. The system monitors network connection condition and determines availability and suitability of each network connection. The system selectively transmits information via a selected network connection. The system seamlessly establishes the multiple connections and transmits the information over the selected network connection and is transparent to the application. (Abstract)

Horn does not teach what is claimed, but rather teaches “[a] system for and a method of managing a communications network through the use of multiple network connections.”

Regarding independent Claims 8, 15 and 22, the Examiner rejected the claims with the same arguments as made for Claim 1. Accordingly, Applicants submit the arguments made for claim 1 apply to claims 8, 15 and 22 and respectfully request that the Examiner withdraw these rejections and for the dependent claims 2-7, 9-14, 16-21 and 23-27, as they are respectively dependent on Claims 1, 8, 15 and 22.

Conclusion

All of the stated grounds of rejection have been properly addressed. Applicants therefore respectfully request that the Examiner reconsider the outstanding rejections. The Examiner is

invited to telephone the undersigned representative if an interview might expedite allowance of this application.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

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By: /Reena Kuyper/
Reena Kuyper
Reg. No. 33,830

Correspondence Address

Cust. No. 49637

Berry & Associates, P.C.

9255 Sunset Boulevard, Suite 810

Los Angeles, CA 90069

Phone: (310) 247-2860

Fax: (310) 247-2864